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Scott W. Kelley
Scott W. Kelley, Reg. No. 30,762

November 3, 2004

Date



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of

Helen Hardman Howlett-Campanella

Serial No. 09/765,533

Filed: January 19, 2001

For: YOGA MAT WITH BODY CONTACT
PLACEMENT INDICIA

Group Art Unit: 3764

Examiner: Lori Baker Amerson

Docket No. HOWL-38283

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPELLANT'S SUPPLEMENTAL REPLY BRIEF (37 C.F.R. § 2.142(b)(1))

This Appellant's Supplemental Reply Brief is submitted in triplicate, pursuant to the provisions of 37 C.F.R. §2,142(b)(1), and in response to the Examiner's Supplemental Answer mailed October 6, 2004, and as authorized by the Board of Patent Appeals and Interferences in its Remand to the Examiner mailed June 24, 2004.

RESPONSE TO EXAMINER'S SUPPLEMENTAL ANSWER: REMAND FROM BOARD

On or about June 24, 2004, the Board of Patent Appeals and Interferences remanded several matters to the Examiner that needed to be addressed before the Board could reach the merits of the issues on appeal. These matters involved: (1) the Campanella and Ferris Declarations; (2) the Examiner's Response (or lack thereof) to the Appellant's Arguments; and (3) the status of the drawings amended by the Appellant.

The Examiner stated that the Campanella and Ferris declarations were entered and considered but otherwise failed to address the content of the declarations. With respect to the term 'marker', the Examiner failed to substantively address the factual evidence and arguments set forth by the Appellant with respect to the Appellant's use of that term. Instead of addressing the facts and arguments raised by the Appellant, the Examiner made conclusory statements bereft of any evidentiary support or supporting law. Furthermore, the Examiner mischaracterized the status of the proposed amendments to the figures and distorted the Appellant's use of a marked-up figure submitted in Appellant's Reply Brief to aid understanding of the Appellant's arguments.

1. The Campanella and Ferris Declarations:

The Board pointed out in the Remand that the Examiner had failed to provide any substantive response in the Examiner's Answer with respect to the points raised in the declarations. The Board further pointed out that the record was not clear whether the declarations had been considered by the Examiner. The Board directed the Examiner to clarify whether or not the Campanella and Ferris Declarations had been entered. If the declarations were entered, the Board directed the Examiner to address Appellant's

arguments drawn to the declarations. The Board quoted MPEP 716.01 to the effect that “[a]ll entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the Examiner in the next succeeding action....Where the evidence is insufficient to overcome the rejection, the Examiner must specifically explain why the evidence is insufficient. General statements such as ‘the declarations lacks technical validity’ or ‘the evidence is not commensurate with the scop of the claims’ without an explanation supporting such finds are insufficient.”

In the Examiner’s Supplemental Answer, the Examiner stated that the Campanella and Ferris Declarations had been entered and considered by the Examiner. However, instead of responding on the merits to the statements made by Ms. Campanella and Ms. Ferris with substantive argument, the Examiner merely made general statements that no factual information had been presented by the declarations to overcome the rejections and that the statements reflected mere opinions by the declarants. The Examiner failed to provide any objectively reasonable explanation to support this position. The Examiner failed to specifically explain why the evidence submitted by the declarants is allegedly insufficient.

The Examiner’s only response was to reject Ms. Campanella’s statements relating to the present invention being directed to a yoga mat, a positive limitation in the claims, as nothing more than an opinion. The Examiner made a conclusory statement to the effect that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art; if the prior art structure is capable of performing the intended use, then it meets the claim. The Examiner fails to provide any supporting

authority for this position but it appears to be taken from Ex parte Masham, 2 USPQ2d 1647 (1987) which the Examiner has quoted before. However, as pointed out in the Appellant's Reply Brief, the Examiner is improperly attempting to employ Ex parte Masham as a *per se* rule that does not address the specific merits of the claimed invention. It is respectfully submitted that the Examiner's attention be directed to In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 425-26, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) have held that the claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103.

As stated in In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970), every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines. The Examiner's desire to ignore positively recited limitations in the claims and failure to take into account the factual statements of Ms. Campanella supporting the positive limitations in the claims that the invention is a yoga mat is inconsistent with the Examiner's duty to meet her burden of proof. Ms. Campanella points out that while the golf mat of Dionne is useful for aiding a golf player to adjust the placement of his/her feet (col. 4, lines 4-14), a yoga mat must be useful for the entire body, not just the feet. A fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all parts of the human body which can be in contact with the mat while only the feet of a user are in contact with a golf mat. A large portion of a yoga practitioner's body can be in contact with

the yoga mat in prone, supine or sitting positions. Even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures. The Examiner fails to substantively address these simple facts.

The Examiner states that the Campanella declaration represents mere opinion as to what the claims are directed to (i.e., a yoga mat) but the Examiner ignores the fact that the Campanella declaration represents the statements of the inventor of the present invention and that Ms. Campanella knows for a fact what she invented. When the inventor states that she invented a yoga mat, she is stating a FACT and not merely expressing an opinion. When the inventor of the present invention states that Dionne fails to disclose a yoga mat and that Dionne only discloses a golf mat, she is stating a FACT uncontroverted by the Examiner. The Examiner has FAILED to point out ANYWHERE in Dionne where it is even remotely suggested that Dionne is intended for or suitable for use as a yoga mat.

The Examiner claims that the circular indicia shown in the figures as originally filed is new matter yet the Examiner fails to address the statements made by Ms. Campanella regarding the circular indicia. Ms. Campanella clearly states, without reservation, in her declaration that one feature shown in various figures of the provisional applications is circular indicia that appear at the intersection of various lines in the figures. The Examiner has admitted that these circular indicia are shown in the figures. Ms. Campanella further states that these circular indicia were intentionally shown in the drawings of the provisional applications. Ms. Campanella is making a statement of FACT, not expressing a mere opinion. Ms. Campanella also states that when the formal drawings of the non-provisional application were created, these circular indicia were intentionally included in the figures of

the non-provisional application. The Examiner has failed to present any evidence to contradict this. Ms. Campanella states that she reviewed the figures prior to the filing of the non-provisional application; figures which clearly include the circular indicia at several intersections of lines. Again, the Examiner fails to provide any evidence to contradict this. Ms. Campanella clearly states these circular indicia, identified as markers 54, 56 and 58 in the amended specification, are not an accidental drawing by-product of several lines intersecting but were intentionally included in the figures. Ms. Campanella has provided the declaration of Ms. Ferris, the draftsman who created the formal drawings, in support of this position. The Examiner's entire theory is based on the claim that these circular indicia are an accidental drawing by-product of several lines intersecting yet the Examiner fails to provide any evidence to support her position. In fact, it is the Examiner who has done nothing but express a mere opinion with respect to the circular indicia.

Ms. Campanella states that her application is directed to a yoga mat. This is uncontroverted by the Examiner. Ms. Campanella states that Dionne et al. (U.S. Patent No. 5,645,494) is directed to a golf mat. Again, this is uncontroverted by the Examiner.

Ms. Campanella states that Dionne fails to disclose a yoga mat; only a golf mat. The Examiner fails to provide any factual support for her position that the golf mat of Dionne is desirable for use as a yoga mat. The Examiner failed to provide any factual support to show that the golf mat of Dionne is suitable for use as a yoga mat.

Ms. Campanella states that her invention is directed to a yoga mat that includes a symmetrical body placement guide on the upper surface of the mat configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. Ms. Campanella reminds the Examiner that a review of Dionne amply illustrates that the

structure and surface of the Dionne golf mat are simply not suitable for the practice of yoga. Ms. Campanella states that the surface of the Dionne golf mat is covered with a harsh Astroturf (col. 3, lines 42-46) and, as shown in Figures 2a and 2b, is not conducive to the type of full-body exercises associated with yoga. Ms. Campanella points out that the golf mat of Dionne is directed only for standing and swinging of a golf club (col. 4, lines 4-22) and that yoga practitioners are well aware that yoga involves all parts of the body and many different positions. Ms. Campanella further explains that a standing position is only one part of yoga and even then, the golf mat of Dionne would not be appropriate for yoga exercises that involve standing. Ms. Campanella contends that while the golf mat of Dionne may be useful for aiding a golf player to adjust the placement of his/her feet (col. 4, lines 4-14), a yoga mat must be useful for the entire body; something the present invention is clearly directed to.

As explained by Ms. Campanella in her declaration, a fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all parts of the human body which can be in contact with the mat while only the feet of a user contact a golf mat. A large portion of a yoga practitioner's body can be in contact with the yoga mat in prone, supine or sitting positions. Even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures. As a matter of structure, design, comfort and functionality, the golf mat of Dionne et al. is simply not suitable for use as a yoga mat, nor is there any suggestion in Dionne et al. that anyone would ever contemplate using that golf mat as a yoga mat.

The Examiner fails to contradict any of the above points made by the Appellant. In fact, the Examiner fails to provide any evidence to support the Examiner's position that the golf mat of Dionne is suitable for use as a yoga mat. The burden is on the Examiner to support the basis of her rejection and the Examiner has utterly failed to do so.

The Examiner attempts to dismiss the Ferris declaration in the same conclusory manner. The Examiner contends that Figures 1-8, as originally filed, in the instant application do not clearly and concisely disclose in the specification, neither claims nor drawings subject matter related to markers. The Examiner fails to provide any evidentiary support or reasonable explanation for her position. Instead, the Examiner ignores the fact that Ms. Ferris is the draftsman who created Figures 1-8 and has first hand knowledge as to what the figures do or do not contain.

Ms. Ferris identified herself as a professional draftsman and that she had drafted the formal figures of the above-identified application. The Examiner fails to rebut the fact that Ms. Ferris has first-hand knowledge of the creation of the formal figures. Ms. Ferris provides that she drafted the formal figures using the figures of the provisional applications 60/177,512 (filed January 21, 2000) and 60/229,868 (filed August 30, 2000); condensing various features of the numerous provisional application figures into a select number of formal drawing figures. Again, the Examiner does not contradict Ms. Ferris' first-hand knowledge of the figures. Ms. Ferris states that she drafted the figures using Adobe Illustrator, a very well-known drafting program. The Examiner does not contradict the fact that Ms. Ferris created the figures with her own hands, so to speak, and therefore knows exactly what is shown and what is not shown in the figures. Ms. Ferris states, clearly and unambiguously, that various figures of the formal figures include circular indicia at several

different intersections of lines and that these circular indicia were shown in the drawings of the provisional applications as originally filed.

Ms. Ferris clearly states that she incorporated these circular indicia into the formal drawings of the non-provisional application and that these circular indicia are identified by reference numbers 54, 56 and 58 in the specification and figures as amended by the Applicant. The Examiner fails to rebut any of this.

Ms. Ferris states that the circular indicia identified by reference numbers 54, 56 and 58 are not an accidental drawing by-product of several lines intersecting but were intentionally included in the figures. Ms. Ferris is stating a FACT since she created the figures. The Examiner fails to provide any rebuttal. In fact, the Examiner has admitted that the circular indicia are shown in the figures but has expressed her mere opinion, based entirely on conjecture rather than fact, that the indicia are a result of a drafting error. Ms. Ferris' declaration leaves no doubt that the circular indicia, clearly shown in the figures as filed, are no drafting error. Between Ms. Ferris' statement and the Examiner's own admission, it is clear that the circular indicia are part of the formal drawings, as original filed and, therefore, not new matter.

In fact, it is the Examiner who has repeatedly presented only her opinion, absolutely bereft of any evidentiary support, that the drawings as originally filed do not support the Appellant's amendments to the specification and claims. When the Examiner contends that Figures 1-8, as originally filed, in the instant application do not clearly and concisely disclose in the specification, neither claims nor drawings subject matter related to markers, the Examiner spits in the face of MPEP Section 2163.06 which clearly states that "information contained in any one of the specifications, claims or drawings of the

application, as filed, may be added to any part of the application without adding new matter"; that the drawings alone are a sufficient basis for adding the description of the circular indicia as 'markers' in the description. The uncontroverted declarations of Campanella and Ferris clearly state that the circular indicia were shown in the figures as originally filed. The Examiner has failed to rebut this evidence and is improperly attempting to require an applicant include evidence and arguments in the specification regarding features shown only in the drawings. This essentially requires a patent applicant, at the time their patent application is filed, to divine objections/rejections the PTO will proffer when the applicant later tries to describe in the written specification any feature that is shown only in the drawings as filed. Fortunately, MPEP 2163.06 makes no such requirement. Under MPEP 2163.06, all that is required is that the circular indicia were shown in the figures of the application as originally filed. The Examiner has failed to provide any explanation to support her position why the drawings, as filed, do not constitute an adequate description of the circular indicia.

Despite admitting that the Declarations of Ms. Campanella and Ms. Ferris had been entered and considered, the Examiner made a throwaway statement that declarations did not indicate why they were not presented earlier. Having admitted that the declarations were entered and considered, the Examiner had rendered moot any question as to why the declarations were not presented earlier. Without waiver of the above, it is clear that the Examiner chooses to ignore the Appellant's clear statement in the Appellant's Reply Brief explaining why the declarations were not presented prior the instant Appeal. The Reply Brief clearly stated that the declarations were submitted in response to the Examiner's unsupported argument that the circular indicia shown in the figures were an

accidental by-product of several lines intersecting. The Appellant had orally communicated this to the Examiner during the first telephonic interview. The declarations had not been submitted earlier because, as discussed in the Appeal Brief in the Record of Interviews, Appellant's Attorney had been waiting to hear back from the Examiner's Supervisory Primary Examiner (SPE) as the SPE had told Appellant's Attorney that he would discuss the new matter issue with the Examiner and get back to Appellant's Attorney. The Examiner's SPE never contacted Appellant's Attorney prior to the last communication from the Examiner stating that the Examiner and her SPE were standing by the rejection. The overwhelming impression given to Appellant by the Examiner and her SPE on the new matter issue was that further prosecution would be futile as there was little doubt that their minds had been made up and an Appeal would be the most expedient way of resolving the new matter issue. The Examiner repeatedly stated that the circular indicia she saw in the figures were nothing more than a drafting error. The declaration of Aleen Ferris leaves no doubt that the circular indicia were not a drafting error and were intentionally shown in the figures. The need to file the Appeal was further buttressed by the Examiner's on-the-record waffling of whether or not Dionne disclosed subject matter relating to indicia positioned and/or extending from at least one of the axis at a 45 degree angle.

In view of the foregoing, it is clear that the Examiner has entered the declarations but has failed to provide any substantive rebuttal to the content of the declarations.

2. Response to Appellant's Arguments:

The Examiner's Supplemental Reply lacks any substantive response to the Appellant's arguments with respect to the use of the term 'marker'. The Board clearly

stated that the Examiner had not provided a full and complete response to the Appellant's arguments in regards to the disputed use of the term 'marker'. The Board stated that the record was not clear whether the Examiner considered the dictionary definition provided by the Appellant.

The Examiner merely stated that she cannot argue the written definition of any term and that her position is that the identification of a 'mark' or marker in the instant application has been arbitrarily and informally labeled based upon the Marquez reference (which the Examiner erroneously refers to as being 'newly discovered'). Instead of addressing the use of the term 'marker' as applied to the circular indicia shown in the figures, the Examiner engages in a tangential tirade with respect to Applicant's desire to provoke an interference with Marquez once the claims are deemed in condition for allowance. The Examiner mischaracterizes the Appellant's desire to provoke an interference with Marquez as some sort of attempt to convince the PTO to declare an interference based upon an application that was not in condition for allowance. The record clearly shows that the Applicant requested that an interference be declared between the instant application and Marquez as Applicant believed that Dionne clearly fails to disclose the claimed invention, leaving the claims in condition for allowance and the application in condition for an interference to be declared.

The Examiner argues that the term 'marker' was not clearly and concisely disclosed in the original specification to warrant entry into the instant application. However, the Examiner fails to provide any evidentiary or case law to support this position. The Examiner argues that because the circular indicia seen in the figures as originally filed were not described as 'markers' in the written description, as originally filed, then the

Appellant is not entitled to refer to these circular indicia in an amended written description as 'markers'. Clearly, the Examiner has once again demonstrated a complete lack of understanding of MPEP Section 2163.06 which unequivocally states that "information contained in any one of the specifications, claims or drawings of the application, as filed, may be added to any part of the application without adding new matter". According to the Examiner, she is right and MPEP 2163.06 is wrong.

The Examiner further failed to provide any definition of 'mark', or 'marker' or specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia shown in the figures is repugnant to the usual meaning of the term.

The Examiner additionally failed to provide any support for the Examiner's contention that the term 'marker' is an additional element separate from indicia forming the body placement guide. The Examiner implied that it was improper for Appellant to take the term 'marker' from Marquez U.S. 5,564,494 which described the same and/or similar circular indicia as a 'marker' yet the Examiner failed to provide any legal basis why it would be improper for Appellant to do so.

Without waiver of the above, it is clear that each of the intersections of the lines themselves, and not just the circular indicia at those intersections, can be described as a 'marker'. For example, as seen in FIG. 8 of Appellant's application (see Exhibit "G" of Appeal Brief), there are fifteen different locations where various lines identified by reference numbers 30, 32, et al. intersect to form a marker. Circular indicia, identified by reference numbers 56, 58 are located at the center of a number of those intersections of lines (i.e, 'markers').

Pursuant to MPEP 2111.01, an applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). In the Examiner's Answer, the Examiner states that the Examiner has consistently remarked that based upon the general definition of a mark, or marker, that there is no evidence in the disclosure to support the indicia Appellant claims as a 'marker'. The Examiner has never provided Appellant with any definition of 'marker' to support her contention. In fact, the Examiner has failed to even acknowledge the definitions of 'marker' and 'mark' provided by the Appellant in the Appeal Brief and has further failed in her Supplemental Examiner's Answer to specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia is repugnant either to the usual meaning of the term or the definitions provided by Appellant. The Examiner has obviously never heard of the age-old expression "X marks the spot". In this case, the circular indicia (as well as the fifteen individual intersections of lines shown in FIG. 8) clearly mark the spot(s) and can therefore be accurately described as 'markers'.

Usage of the term 'marker' to describe the circular indicia is repugnant neither to the term's well known usage nor the definitions provided by Appellant. The use of the term is completely consistent with the use of the same term in the Marquez patent as Marquez uses that very same term to describe circular indicia on the surface of the Marquez mat. The term 'marker' is therefore not being used in any manner as to give it a special meaning or a meaning repugnant to the usual meaning of the term. See MPEP 608.01(o) [Basis for Claim Terminology in Description].

Based upon the foregoing definitions, the manner in which the term 'marker' is used in the specification, and the source of the term (i.e., Marquez), it is clear that the term properly describes the circular indicia shown in the figures, especially in view of the intent to keep the language of claim 23 consistent with Marquez. The term 'marker' is completely consistent with the specification to describe the body placement guide as providing various marks/markers for a yoga practitioner to use to align their body during yoga exercises.

Based on the foregoing, it is clear that the term 'marker' is an appropriate word to use to describe the circular indicia shown in the figure, as originally filed.

3. Drawings:

The Examiner's Supplemental Reply, rather than clarifying the status of the amended drawings, has only further muddled the waters. The Board clearly stated that the present record is not clear as to whether the amended drawings submitted with the Response, filed August 19, 2002, has been properly entered into the record and approved by the Examiner. The Examiner failed to address these particular proposed amendments to the drawings and only mentioned drawings filed October 6, 2003 and February 11, 2004.

The Examiner disapproved of the proposed amendments to the figures filed by the Appellant on August 19, 2002 on the basis that the amended figures allegedly contained 'new matter' (i.e., reference numbers pointing to the circular indicia shown in the figures). As outlined above, the reference numbers are clearly not new matter as they reference numbers only point to circular indicia that were present in the figures at the time the figures were originally filed.

The amended figure of FIG. 8 submitted with the declaration of Ms. Ferris in October 6, 2003, was not entered by the Examiner. In her declaration, Ms. Ferris pointed out an error she found in the Appellant's proposed amendment to FIG. 8 filed on August 19, 2002. Ms. Ferris stated that the August 19, 2002 amendment to FIG. 8 was correct except for a single error. Ms. Ferris continued on to state that while the circular indicia in FIG. 8 are properly identified by reference numbers 56 and 58 at the intersections of the longitudinal axis 30 (i.e., the center vertical lines) with various lines, the reference numbers 58 that point to the intersections of the lines that are parallel to the left or right of the longitudinal axis 30 are incorrect and Ms. Ferris provided a corrected version of Figure 8 to be submitted for approval by the Board/Examiner that was attached to her declaration. However, the Examiner will not enter the proposed amendments as she considers the addition of the reference numbers pointing to the circular indicia to be 'new matter' despite the fact that the circular indicia were shown in the figures as they were originally filed.

With respect to the so-called 'formal drawings' filed February 11, 2004, it is clear that the Examiner did not even bother read the Appellant's Reply Brief in which the Appellant submitted a figure in Exhibit A. The Examiner states that FIG. 8 of Exhibit A of the Reply Brief includes additional handwritten lines [and labeling] that were not originally filed. This is true but had the Examiner actually read the Reply Brief, she would have found that page 22, first paragraph, of the Reply Brief clearly states that "[a] marked up version of FIG. 8 (with the lines forming the sides of the rectangles completed in phantom) has been provided for the purpose of providing clarity and is attached hereto in the Appendix as Exhibit 'A'". Nowhere did the Appellant state that the figure was being submitted as a formal drawing to be entered by the Examiner. On the contrary, the

Appellant clearly indicated that the marked up FIG. 8 in Exhibit A was only being submitted to provide clarity while reading the Appellant's following argument.

For the foregoing reasons, the rejections to the claims should be overturned.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

By: 

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(submitted in triplicate)

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 3, 2004.



Scott W. Kelley
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November 3, 2004
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Helen Hardman Howlett-Campanella

Serial No. 09/765,533

Filed: January 19, 2001

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PLACEMENT INDICIA

Group Art Unit: 3764

Examiner: Lori Baker Amerson

Docket No. HOWL-38283

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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The Examiner stated that the Campanella and Ferris declarations were entered and considered but otherwise failed to address the content of the declarations. With respect to the term 'marker', the Examiner failed to substantively address the factual evidence and arguments set forth by the Appellant with respect to the Appellant's use of that term. Instead of addressing the facts and arguments raised by the Appellant, the Examiner made conclusory statements bereft of any evidentiary support or supporting law. Furthermore, the Examiner mischaracterized the status of the proposed amendments to the figures and distorted the Appellant's use of a marked-up figure submitted in Appellant's Reply Brief to aid understanding of the Appellant's arguments.

1. The Campanella and Ferris Declarations:

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authority for this position but it appears to be taken from Ex parte Masham, 2 USPQ2d 1647 (1987) which the Examiner has quoted before. However, as pointed out in the Appellant's Reply Brief, the Examiner is improperly attempting to employ Ex parte Masham as a *per se* rule that does not address the specific merits of the claimed invention. It is respectfully submitted that the Examiner's attention be directed to In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 425-26, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) have held that the claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103.

As stated in In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970), every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines. The Examiner's desire to ignore positively recited limitations in the claims and failure to take into account the factual statements of Ms. Campanella supporting the positive limitations in the claims that the invention is a yoga mat is inconsistent with the Examiner's duty to meet her burden of proof. Ms. Campanella points out that while the golf mat of Dionne is useful for aiding a golf player to adjust the placement of his/her feet (col. 4, lines 4-14), a yoga mat must be useful for the entire body, not just the feet. A fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all parts of the human body which can be in contact with the mat while only the feet of a user are in contact with a golf mat. A large portion of a yoga practitioner's body can be in contact with

the yoga mat in prone, supine or sitting positions. Even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures. The Examiner fails to substantively address these simple facts.

The Examiner states that the Campanella declaration represents mere opinion as to what the claims are directed to (i.e., a yoga mat) but the Examiner ignores the fact that the Campanella declaration represents the statements of the inventor of the present invention and that Ms. Campanella knows for a fact what she invented. When the inventor states that she invented a yoga mat, she is stating a FACT and not merely expressing an opinion. When the inventor of the present invention states that Dionne fails to disclose a yoga mat and that Dionne only discloses a golf mat, she is stating a FACT uncontroverted by the Examiner. The Examiner has FAILED to point out ANYWHERE in Dionne where it is even remotely suggested that Dionne is intended for or suitable for use as a yoga mat.

The Examiner claims that the circular indicia shown in the figures as originally filed is new matter yet the Examiner fails to address the statements made by Ms. Campanella regarding the circular indicia. Ms. Campanella clearly states, without reservation, in her declaration that one feature shown in various figures of the provisional applications is circular indicia that appear at the intersection of various lines in the figures. The Examiner has admitted that these circular indicia are shown in the figures. Ms. Campanella further states that these circular indicia were intentionally shown in the drawings of the provisional applications. Ms. Campanella is making a statement of FACT, not expressing a mere opinion. Ms. Campanella also states that when the formal drawings of the non-provisional application were created, these circular indicia were intentionally included in the figures of

the non-provisional application. The Examiner has failed to present any evidence to contradict this. Ms. Campanella states that she reviewed the figures prior to the filing of the non-provisional application; figures which clearly include the circular indicia at several intersections of lines. Again, the Examiner fails to provide any evidence to contradict this. Ms. Campanella clearly states these circular indicia, identified as markers 54, 56 and 58 in the amended specification, are not an accidental drawing by-product of several lines intersecting but were intentionally included in the figures. Ms. Campanella has provided the declaration of Ms. Ferris, the draftsman who created the formal drawings, in support of this position. The Examiner's entire theory is based on the claim that these circular indicia are an accidental drawing by-product of several lines intersecting yet the Examiner fails to provide any evidence to support her position. In fact, it is the Examiner who has done nothing but express a mere opinion with respect to the circular indicia.

Ms. Campanella states that her application is directed to a yoga mat. This is uncontroverted by the Examiner. Ms. Campanella states that Dionne et al. (U.S. Patent No. 5,645,494) is directed to a golf mat. Again, this is uncontroverted by the Examiner.

Ms. Campanella states that Dionne fails to disclose a yoga mat; only a golf mat. The Examiner fails to provide any factual support for her position that the golf mat of Dionne is desirable for use as a yoga mat. The Examiner failed to provide any factual support to show that the golf mat of Dionne is suitable for use as a yoga mat.

Ms. Campanella states that her invention is directed to a yoga mat that includes a symmetrical body placement guide on the upper surface of the mat configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. Ms. Campanella reminds the Examiner that a review of Dionne amply illustrates that the

structure and surface of the Dionne golf mat are simply not suitable for the practice of yoga. Ms. Campanella states that the surface of the Dionne golf mat is covered with a harsh Astroturf (col. 3, lines 42-46) and, as shown in Figures 2a and 2b, is not conducive to the type of full-body exercises associated with yoga. Ms. Campanella points out that the golf mat of Dionne is directed only for standing and swinging of a golf club (col. 4, lines 4-22) and that yoga practitioners are well aware that yoga involves all parts of the body and many different positions. Ms. Campanella further explains that a standing position is only one part of yoga and even then, the golf mat of Dionne would not be appropriate for yoga exercises that involve standing. Ms. Campanella contends that while the golf mat of Dionne may be useful for aiding a golf player to adjust the placement of his/her feet (col. 4, lines 4-14), a yoga mat must be useful for the entire body; something the present invention is clearly directed to.

As explained by Ms. Campanella in her declaration, a fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all parts of the human body which can be in contact with the mat while only the feet of a user contact a golf mat. A large portion of a yoga practitioner's body can be in contact with the yoga mat in prone, supine or sitting positions. Even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures. As a matter of structure, design, comfort and functionality, the golf mat of Dionne et al. is simply not suitable for use as a yoga mat, nor is there any suggestion in Dionne et al. that anyone would ever contemplate using that golf mat as a yoga mat.

The Examiner fails to contradict any of the above points made by the Appellant. In fact, the Examiner fails to provide any evidence to support the Examiner's position that the golf mat of Dionne is suitable for use as a yoga mat. The burden is on the Examiner to support the basis of her rejection and the Examiner has utterly failed to do so.

The Examiner attempts to dismiss the Ferris declaration in the same conclusory manner. The Examiner contends that Figures 1-8, as originally filed, in the instant application do not clearly and concisely disclose in the specification, neither claims nor drawings subject matter related to markers. The Examiner fails to provide any evidentiary support or reasonable explanation for her position. Instead, the Examiner ignores the fact that Ms. Ferris is the draftsman who created Figures 1-8 and has first hand knowledge as to what the figures do or do not contain.

Ms. Ferris identified herself as a professional draftsman and that she had drafted the formal figures of the above-identified application. The Examiner fails to rebut the fact that Ms. Ferris has first-hand knowledge of the creation of the formal figures. Ms. Ferris provides that she drafted the formal figures using the figures of the provisional applications 60/177,512 (filed January 21, 2000) and 60/229,868 (filed August 30, 2000); condensing various features of the numerous provisional application figures into a select number of formal drawing figures. Again, the Examiner does not contradict Ms. Ferris' first-hand knowledge of the figures. Ms. Ferris states that she drafted the figures using Adobe Illustrator, a very well-known drafting program. The Examiner does not contradict the fact that Ms. Ferris created the figures with her own hands, so to speak, and therefore knows exactly what is shown and what is not shown in the figures. Ms. Ferris states, clearly and unambiguously, that various figures of the formal figures include circular indicia at several

different intersections of lines and that these circular indicia were shown in the drawings of the provisional applications as originally filed.

Ms. Ferris clearly states that she incorporated these circular indicia into the formal drawings of the non-provisional application and that these circular indicia are identified by reference numbers 54, 56 and 58 in the specification and figures as amended by the Applicant. The Examiner fails to rebut any of this.

Ms. Ferris states that the circular indicia identified by reference numbers 54, 56 and 58 are not an accidental drawing by-product of several lines intersecting but were intentionally included in the figures. Ms. Ferris is stating a FACT since she created the figures. The Examiner fails to provide any rebuttal. In fact, the Examiner has admitted that the circular indicia are shown in the figures but has expressed her mere opinion, based entirely on conjecture rather than fact, that the indicia are a result of a drafting error. Ms. Ferris' declaration leaves no doubt that the circular indicia, clearly shown in the figures as filed, are no drafting error. Between Ms. Ferris' statement and the Examiner's own admission, it is clear that the circular indicia are part of the formal drawings, as original filed and, therefore, not new matter.

In fact, it is the Examiner who has repeatedly presented only her opinion, absolutely bereft of any evidentiary support, that the drawings as originally filed do not support the Appellant's amendments to the specification and claims. When the Examiner contends that Figures 1-8, as originally filed, in the instant application do not clearly and concisely disclose in the specification, neither claims nor drawings subject matter related to markers, the Examiner spits in the face of MPEP Section 2163.06 which clearly states that "information contained in any one of the specifications, claims or drawings of the

application, as filed, may be added to any part of the application without adding new matter"; that the drawings alone are a sufficient basis for adding the description of the circular indicia as 'markers' in the description. The uncontroverted declarations of Campanella and Ferris clearly state that the circular indicia were shown in the figures as originally filed. The Examiner has failed to rebut this evidence and is improperly attempting to require an applicant include evidence and arguments in the specification regarding features shown only in the drawings. This essentially requires a patent applicant, at the time their patent application is filed, to divine objections/rejections the PTO will proffer when the applicant later tries to describe in the written specification any feature that is shown only in the drawings as filed. Fortunately, MPEP 2163.06 makes no such requirement. Under MPEP 2163.06, all that is required is that the circular indicia were shown in the figures of the application as originally filed. The Examiner has failed to provide any explanation to support her position why the drawings, as filed, do not constitute an adequate description of the circular indicia.

Despite admitting that the Declarations of Ms. Campanella and Ms. Ferris had been entered and considered, the Examiner made a throwaway statement that declarations did not indicate why they were not presented earlier. Having admitted that the declarations were entered and considered, the Examiner had rendered moot any question as to why the declarations were not presented earlier. Without waiver of the above, it is clear that the Examiner chooses to ignore the Appellant's clear statement in the Appellant's Reply Brief explaining why the declarations were not presented prior the instant Appeal. The Reply Brief clearly stated that the declarations were submitted in response to the Examiner's unsupported argument that the circular indicia shown in the figures were an

accidental by-product of several lines intersecting. The Appellant had orally communicated this to the Examiner during the first telephonic interview. The declarations had not been submitted earlier because, as discussed in the Appeal Brief in the Record of Interviews, Appellant's Attorney had been waiting to hear back from the Examiner's Supervisory Primary Examiner (SPE) as the SPE had told Appellant's Attorney that he would discuss the new matter issue with the Examiner and get back to Appellant's Attorney. The Examiner's SPE never contacted Appellant's Attorney prior to the last communication from the Examiner stating that the Examiner and her SPE were standing by the rejection. The overwhelming impression given to Appellant by the Examiner and her SPE on the new matter issue was that further prosecution would be futile as there was little doubt that their minds had been made up and an Appeal would be the most expedient way of resolving the new matter issue. The Examiner repeatedly stated that the circular indicia she saw in the figures were nothing more than a drafting error. The declaration of Aleen Ferris leaves no doubt that the circular indicia were not a drafting error and were intentionally shown in the figures. The need to file the Appeal was further buttressed by the Examiner's on-the-record waffling of whether or not Dionne disclosed subject matter relating to indicia positioned and/or extending from at least one of the axis at a 45 degree angle.

In view of the foregoing, it is clear that the Examiner has entered the declarations but has failed to provide any substantive rebuttal to the content of the declarations.

2. Response to Appellant's Arguments:

The Examiner's Supplemental Reply lacks any substantive response to the Appellant's arguments with respect to the use of the term 'marker'. The Board clearly

stated that the Examiner had not provided a full and complete response to the Appellant's arguments in regards to the disputed use of the term 'marker'. The Board stated that the record was not clear whether the Examiner considered the dictionary definition provided by the Appellant.

The Examiner merely stated that she cannot argue the written definition of any term and that her position is that the identification of a 'mark' or marker in the instant application has been arbitrarily and informally labeled based upon the Marquez reference (which the Examiner erroneously refers to as being 'newly discovered'). Instead of addressing the use of the term 'marker' as applied to the circular indicia shown in the figures, the Examiner engages in a tangential tirade with respect to Applicant's desire to provoke an interference with Marquez once the claims are deemed in condition for allowance. The Examiner mischaracterizes the Appellant's desire to provoke an interference with Marquez as some sort of attempt to convince the PTO to declare an interference based upon an application that was not in condition for allowance. The record clearly shows that the Applicant requested that an interference be declared between the instant application and Marquez as Applicant believed that Dionne clearly fails to disclose the claimed invention, leaving the claims in condition for allowance and the application in condition for an interference to be declared.

The Examiner argues that the term 'marker' was not clearly and concisely disclosed in the original specification to warrant entry into the instant application. However, the Examiner fails to provide any evidentiary or case law to support this position. The Examiner argues that because the circular indicia seen in the figures as originally filed were not described as 'markers' in the written description, as originally filed, then the

Appellant is not entitled to refer to these circular indicia in an amended written description as 'markers'. Clearly, the Examiner has once again demonstrated a complete lack of understanding of MPEP Section 2163.06 which unequivocally states that "information contained in any one of the specifications, claims or drawings of the application, as filed, may be added to any part of the application without adding new matter". According to the Examiner, she is right and MPEP 2163.06 is wrong.

The Examiner further failed to provide any definition of 'mark', or 'marker' or specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia shown in the figures is repugnant to the usual meaning of the term.

The Examiner additionally failed to provide any support for the Examiner's contention that the term 'marker' is an additional element separate from indicia forming the body placement guide. The Examiner implied that it was improper for Appellant to take the term 'marker' from Marquez U.S. 5,564,494 which described the same and/or similar circular indicia as a 'marker' yet the Examiner failed to provide any legal basis why it would be improper for Appellant to do so.

Without waiver of the above, it is clear that each of the intersections of the lines themselves, and not just the circular indicia at those intersections, can be described as a 'marker'. For example, as seen in FIG. 8 of Appellant's application (see Exhibit "G" of Appeal Brief), there are fifteen different locations where various lines identified by reference numbers 30, 32, et al. intersect to form a marker. Circular indicia, identified by reference numbers 56, 58 are located at the center of a number of those intersections of lines (i.e., 'markers').

Pursuant to MPEP 2111.01, an applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). In the Examiner's Answer, the Examiner states that the Examiner has consistently remarked that based upon the general definition of a mark, or marker, that there is no evidence in the disclosure to support the indicia Appellant claims as a 'marker'. The Examiner has never provided Appellant with any definition of 'marker' to support her contention. In fact, the Examiner has failed to even acknowledge the definitions of 'marker' and 'mark' provided by the Appellant in the Appeal Brief and has further failed in her Supplemental Examiner's Answer to specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia is repugnant either to the usual meaning of the term or the definitions provided by Appellant. The Examiner has obviously never heard of the age-old expression "X marks the spot". In this case, the circular indicia (as well as the fifteen individual intersections of lines shown in FIG. 8) clearly mark the spot(s) and can therefore be accurately described as 'markers'.

Usage of the term 'marker' to describe the circular indicia is repugnant neither to the term's well known usage nor the definitions provided by Appellant. The use of the term is completely consistent with the use of the same term in the Marquez patent as Marquez uses that very same term to describe circular indicia on the surface of the Marquez mat. The term 'marker' is therefore not being used in any manner as to give it a special meaning or a meaning repugnant to the usual meaning of the term. See MPEP 608.01(o) [Basis for Claim Terminology in Description].

Based upon the foregoing definitions, the manner in which the term 'marker' is used in the specification, and the source of the term (i.e., Marquez), it is clear that the term properly describes the circular indicia shown in the figures, especially in view of the intent to keep the language of claim 23 consistent with Marquez. The term 'marker' is completely consistent with the specification to describe the body placement guide as providing various marks/markers for a yoga practitioner to use to align their body during yoga exercises.

Based on the foregoing, it is clear that the term 'marker' is an appropriate word to use to describe the circular indicia shown in the figure, as originally filed.

3. Drawings:

The Examiner's Supplemental Reply, rather than clarifying the status of the amended drawings, has only further muddled the waters. The Board clearly stated that the present record is not clear as to whether the amended drawings submitted with the Response, filed August 19, 2002, has been properly entered into the record and approved by the Examiner. The Examiner failed to address these particular proposed amendments to the drawings and only mentioned drawings filed October 6, 2003 and February 11, 2004.

The Examiner disapproved of the proposed amendments to the figures filed by the Appellant on August 19, 2002 on the basis that the amended figures allegedly contained 'new matter' (i.e., reference numbers pointing to the circular indicia shown in the figures). As outlined above, the reference numbers are clearly not new matter as they reference numbers only point to circular indicia that were present in the figures at the time the figures were originally filed.

The amended figure of FIG. 8 submitted with the declaration of Ms. Ferris in October 6, 2003, was not entered by the Examiner. In her declaration, Ms. Ferris pointed out an error she found in the Appellant's proposed amendment to FIG. 8 filed on August 19, 2002. Ms. Ferris stated that the August 19, 2002 amendment to FIG. 8 was correct except for a single error. Ms. Ferris continued on to state that while the circular indicia in FIG. 8 are properly identified by reference numbers 56 and 58 at the intersections of the longitudinal axis 30 (i.e., the center vertical lines) with various lines, the reference numbers 58 that point to the intersections of the lines that are parallel to the left or right of the longitudinal axis 30 are incorrect and Ms. Ferris provided a corrected version of Figure 8 to be submitted for approval by the Board/Examiner that was attached to her declaration. However, the Examiner will not enter the proposed amendments as she considers the addition of the reference numbers pointing to the circular indicia to be 'new matter' despite the fact that the circular indicia were shown in the figures as they were originally filed.

With respect to the so-called 'formal drawings' filed February 11, 2004, it is clear that the Examiner did not even bother read the Appellant's Reply Brief in which the Appellant submitted a figure in Exhibit A. The Examiner states that FIG. 8 of Exhibit A of the Reply Brief includes additional handwritten lines [and labeling] that were not originally filed. This is true but had the Examiner actually read the Reply Brief, she would have found that page 22, first paragraph, of the Reply Brief clearly states that "[a] marked up version of FIG. 8 (with the lines forming the sides of the rectangles completed in phantom) has been provided for the purpose of providing clarity and is attached hereto in the Appendix as Exhibit 'A'". Nowhere did the Appellant state that the figure was being submitted as a formal drawing to be entered by the Examiner. On the contrary, the

Appellant clearly indicated that the marked up FIG. 8 in Exhibit A was only being submitted to provide clarity while reading the Appellant's following argument.

For the foregoing reasons, the rejections to the claims should be overturned.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

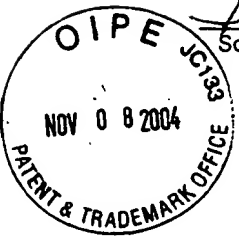
By: 

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 3, 2004.



Scott W. Kelley
Scott W. Kelley, Reg. No. 30,762

November 3, 2004
Date

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application of

Helen Hardman Howlett-Campanella

Serial No. 09/765,533

Filed: January 19, 2001

For: YOGA MAT WITH BODY CONTACT
PLACEMENT INDICIA

Group Art Unit: 3764

Examiner: Lori Baker Amerson

Docket No. HOWL-38283

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPELLANT'S SUPPLEMENTAL REPLY BRIEF (37 C.F.R. § 2.142(b)(1))

This Appellant's Supplemental Reply Brief is submitted in triplicate, pursuant to the provisions of 37 C.F.R. §2,142(b)(1), and in response to the Examiner's Supplemental Answer mailed October 6, 2004, and as authorized by the Board of Patent Appeals and Interferences in its Remand to the Examiner mailed June 24, 2004.

RESPONSE TO EXAMINER'S SUPPLEMENTAL ANSWER: REMAND FROM BOARD

On or about June 24, 2004, the Board of Patent Appeals and Interferences remanded several matters to the Examiner that needed to be addressed before the Board could reach the merits of the issues on appeal. These matters involved: (1) the Campanella and Ferris Declarations; (2) the Examiner's Response (or lack thereof) to the Appellant's Arguments; and (3) the status of the drawings amended by the Appellant.

The Examiner stated that the Campanella and Ferris declarations were entered and considered but otherwise failed to address the content of the declarations. With respect to the term 'marker', the Examiner failed to substantively address the factual evidence and arguments set forth by the Appellant with respect to the Appellant's use of that term. Instead of addressing the facts and arguments raised by the Appellant, the Examiner made conclusory statements bereft of any evidentiary support or supporting law. Furthermore, the Examiner mischaracterized the status of the proposed amendments to the figures and distorted the Appellant's use of a marked-up figure submitted in Appellant's Reply Brief to aid understanding of the Appellant's arguments.

1. The Campanella and Ferris Declarations:

The Board pointed out in the Remand that the Examiner had failed to provide any substantive response in the Examiner's Answer with respect to the points raised in the declarations. The Board further pointed out that the record was not clear whether the declarations had been considered by the Examiner. The Board directed the Examiner to clarify whether or not the Campanella and Ferris Declarations had been entered. If the declarations were entered, the Board directed the Examiner to address Appellant's

arguments drawn to the declarations. The Board quoted MPEP 716.01 to the effect that “[a]ll entered affidavits, declarations, and other evidence traversing rejections are acknowledged and commented upon by the Examiner in the next succeeding action....Where the evidence is insufficient to overcome the rejection, the Examiner must specifically explain why the evidence is insufficient. General statements such as ‘the declarations lacks technical validity’ or ‘the evidence is not commensurate with the scop of the claims’ without an explanation supporting such finds are insufficient.”

In the Examiner's Supplemental Answer, the Examiner stated that the Campanella and Ferris Declarations had been entered and considered by the Examiner. However, instead of responding on the merits to the statements made by Ms. Campanella and Ms. Ferris with substantive argument, the Examiner merely made general statements that no factual information had been presented by the declarations to overcome the rejections and that the statements reflected mere opinions by the declarants. The Examiner failed to provide any objectively reasonable explanation to support this position. The Examiner failed to specifically explain why the evidence submitted by the declarants is allegedly insufficient.

The Examiner's only response was to reject Ms. Campanella's statements relating to the present invention being directed to a yoga mat, a positive limitation in the claims, as nothing more than an opinion. The Examiner made a conclusory statement to the effect that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art; if the prior art structure is capable of performing the intended use, then it meets the claim. The Examiner fails to provide any supporting

authority for this position but it appears to be taken from Ex parte Masham, 2 USPQ2d 1647 (1987) which the Examiner has quoted before. However, as pointed out in the Appellant's Reply Brief, the Examiner is improperly attempting to employ Ex parte Masham as a *per se* rule that does not address the specific merits of the claimed invention. It is respectfully submitted that the Examiner's attention be directed to In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) and In re Brouwer, 77 F.3d 422, 425-26, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) have held that the claimed invention as a whole must be evaluated under the standards set down in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), and its progeny, and that the use of *per se* rules is improper in applying the test for obviousness under 35 U.S.C. 103 since such rules are inconsistent with the fact-specific analysis of claims and prior art mandated by section 103.

As stated in In re Wilder, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970), every limitation positively recited in a claim must be given effect in order to determine what subject matter that claim defines. The Examiner's desire to ignore positively recited limitations in the claims and failure to take into account the factual statements of Ms. Campanella supporting the positive limitations in the claims that the invention is a yoga mat is inconsistent with the Examiner's duty to meet her burden of proof. Ms. Campanella points out that while the golf mat of Dionne is useful for aiding a golf player to adjust the placement of his/her feet (col. 4, lines 4-14), a yoga mat must be useful for the entire body, not just the feet. A fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all parts of the human body which can be in contact with the mat while only the feet of a user are in contact with a golf mat. A large portion of a yoga practitioner's body can be in contact with

the yoga mat in prone, supine or sitting positions. Even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures. The Examiner fails to substantively address these simple facts.

The Examiner states that the Campanella declaration represents mere opinion as to what the claims are directed to (i.e., a yoga mat) but the Examiner ignores the fact that the Campanella declaration represents the statements of the inventor of the present invention and that Ms. Campanella knows for a fact what she invented. When the inventor states that she invented a yoga mat, she is stating a FACT and not merely expressing an opinion. When the inventor of the present invention states that Dionne fails to disclose a yoga mat and that Dionne only discloses a golf mat, she is stating a FACT uncontroverted by the Examiner. The Examiner has FAILED to point out ANYWHERE in Dionne where it is even remotely suggested that Dionne is intended for or suitable for use as a yoga mat.

The Examiner claims that the circular indicia shown in the figures as originally filed is new matter yet the Examiner fails to address the statements made by Ms. Campanella regarding the circular indicia. Ms. Campanella clearly states, without reservation, in her declaration that one feature shown in various figures of the provisional applications is circular indicia that appear at the intersection of various lines in the figures. The Examiner has admitted that these circular indicia are shown in the figures. Ms. Campanella further states that these circular indicia were intentionally shown in the drawings of the provisional applications. Ms. Campanella is making a statement of FACT, not expressing a mere opinion. Ms. Campanella also states that when the formal drawings of the non-provisional application were created, these circular indicia were intentionally included in the figures of

the non-provisional application. The Examiner has failed to present any evidence to contradict this. Ms. Campanella states that she reviewed the figures prior to the filing of the non-provisional application; figures which clearly include the circular indicia at several intersections of lines. Again, the Examiner fails to provide any evidence to contradict this. Ms. Campanella clearly states these circular indicia, identified as markers 54, 56 and 58 in the amended specification, are not an accidental drawing by-product of several lines intersecting but were intentionally included in the figures. Ms. Campanella has provided the declaration of Ms. Ferris, the draftsman who created the formal drawings, in support of this position. The Examiner's entire theory is based on the claim that these circular indicia are an accidental drawing by-product of several lines intersecting yet the Examiner fails to provide any evidence to support her position. In fact, it is the Examiner who has done nothing but express a mere opinion with respect to the circular indicia.

Ms. Campanella states that her application is directed to a yoga mat. This is uncontroverted by the Examiner. Ms. Campanella states that Dionne et al. (U.S. Patent No. 5,645,494) is directed to a golf mat. Again, this is uncontroverted by the Examiner.

Ms. Campanella states that Dionne fails to disclose a yoga mat; only a golf mat. The Examiner fails to provide any factual support for her position that the golf mat of Dionne is desirable for use as a yoga mat. The Examiner failed to provide any factual support to show that the golf mat of Dionne is suitable for use as a yoga mat.

Ms. Campanella states that her invention is directed to a yoga mat that includes a symmetrical body placement guide on the upper surface of the mat configured to aid a yoga practitioner to properly align the practitioner's body during yoga postures. Ms. Campanella reminds the Examiner that a review of Dionne amply illustrates that the

structure and surface of the Dionne golf mat are simply not suitable for the practice of yoga. Ms. Campanella states that the surface of the Dionne golf mat is covered with a harsh Astroturf (col. 3, lines 42-46) and, as shown in Figures 2a and 2b, is not conducive to the type of full-body exercises associated with yoga. Ms. Campanella points out that the golf mat of Dionne is directed only for standing and swinging of a golf club (col. 4, lines 4-22) and that yoga practitioners are well aware that yoga involves all parts of the body and many different positions. Ms. Campanella further explains that a standing position is only one part of yoga and even then, the golf mat of Dionne would not be appropriate for yoga exercises that involve standing. Ms. Campanella contends that while the golf mat of Dionne may be useful for aiding a golf player to adjust the placement of his/her feet (col. 4, lines 4-14), a yoga mat must be useful for the entire body; something the present invention is clearly directed to.

As explained by Ms. Campanella in her declaration, a fundamental part of yoga is moving the body into various positions using combinations of various movements; movements which can involve all parts of the human body which can be in contact with the mat while only the feet of a user contact a golf mat. A large portion of a yoga practitioner's body can be in contact with the yoga mat in prone, supine or sitting positions. Even if the yoga practitioner is up off the floor, the yoga practitioner may be standing, kneeling on hands and feet, hands and knees, headstand, elbow stand, handstand and so on as there are over one thousand yoga postures. As a matter of structure, design, comfort and functionality, the golf mat of Dionne et al. is simply not suitable for use as a yoga mat, nor is there any suggestion in Dionne et al. that anyone would ever contemplate using that golf mat as a yoga mat.

The Examiner fails to contradict any of the above points made by the Appellant. In fact, the Examiner fails to provide any evidence to support the Examiner's position that the golf mat of Dionne is suitable for use as a yoga mat. The burden is on the Examiner to support the basis of her rejection and the Examiner has utterly failed to do so.

The Examiner attempts to dismiss the Ferris declaration in the same conclusory manner. The Examiner contends that Figures 1-8, as originally filed, in the instant application do not clearly and concisely disclose in the specification, neither claims nor drawings subject matter related to markers. The Examiner fails to provide any evidentiary support or reasonable explanation for her position. Instead, the Examiner ignores the fact that Ms. Ferris is the draftsman who created Figures 1-8 and has first hand knowledge as to what the figures do or do not contain.

Ms. Ferris identified herself as a professional draftsman and that she had drafted the formal figures of the above-identified application. The Examiner fails to rebut the fact that Ms. Ferris has first-hand knowledge of the creation of the formal figures. Ms. Ferris provides that she drafted the formal figures using the figures of the provisional applications 60/177,512 (filed January 21, 2000) and 60/229,868 (filed August 30, 2000); condensing various features of the numerous provisional application figures into a select number of formal drawing figures. Again, the Examiner does not contradict Ms. Ferris' first-hand knowledge of the figures. Ms. Ferris states that she drafted the figures using Adobe Illustrator, a very well-known drafting program. The Examiner does not contradict the fact that Ms. Ferris created the figures with her own hands, so to speak, and therefore knows exactly what is shown and what is not shown in the figures. Ms. Ferris states, clearly and unambiguously, that various figures of the formal figures include circular indicia at several

different intersections of lines and that these circular indicia were shown in the drawings of the provisional applications as originally filed.

Ms. Ferris clearly states that she incorporated these circular indicia into the formal drawings of the non-provisional application and that these circular indicia are identified by reference numbers 54, 56 and 58 in the specification and figures as amended by the Applicant. The Examiner fails to rebut any of this.

Ms. Ferris states that the circular indicia identified by reference numbers 54, 56 and 58 are not an accidental drawing by-product of several lines intersecting but were intentionally included in the figures. Ms. Ferris is stating a FACT since she created the figures. The Examiner fails to provide any rebuttal. In fact, the Examiner has admitted that the circular indicia are shown in the figures but has expressed her mere opinion, based entirely on conjecture rather than fact, that the indicia are a result of a drafting error. Ms. Ferris' declaration leaves no doubt that the circular indicia, clearly shown in the figures as filed, are no drafting error. Between Ms. Ferris' statement and the Examiner's own admission, it is clear that the circular indicia are part of the formal drawings, as original filed and, therefore, not new matter.

In fact, it is the Examiner who has repeatedly presented only her opinion, absolutely bereft of any evidentiary support, that the drawings as originally filed do not support the Appellant's amendments to the specification and claims. When the Examiner contends that Figures 1-8, as originally filed, in the instant application do not clearly and concisely disclose in the specification, neither claims nor drawings subject matter related to markers, the Examiner spits in the face of MPEP Section 2163.06 which clearly states that "information contained in any one of the specifications, claims or drawings of the

application, as filed, may be added to any part of the application without adding new matter"; that the drawings alone are a sufficient basis for adding the description of the circular indicia as 'markers' in the description. The uncontroverted declarations of Campanella and Ferris clearly state that the circular indicia were shown in the figures as originally filed. The Examiner has failed to rebut this evidence and is improperly attempting to require an applicant include evidence and arguments in the specification regarding features shown only in the drawings. This essentially requires a patent applicant, at the time their patent application is filed, to divine objections/rejections the PTO will proffer when the applicant later tries to describe in the written specification any feature that is shown only in the drawings as filed. Fortunately, MPEP 2163.06 makes no such requirement. Under MPEP 2163.06, all that is required is that the circular indicia were shown in the figures of the application as originally filed. The Examiner has failed to provide any explanation to support her position why the drawings, as filed, do not constitute an adequate description of the circular indicia.

Despite admitting that the Declarations of Ms. Campanella and Ms. Ferris had been entered and considered, the Examiner made a throwaway statement that declarations did not indicate why they were not presented earlier. Having admitted that the declarations were entered and considered, the Examiner had rendered moot any question as to why the declarations were not presented earlier. Without waiver of the above, it is clear that the Examiner chooses to ignore the Appellant's clear statement in the Appellant's Reply Brief explaining why the declarations were not presented prior the instant Appeal. The Reply Brief clearly stated that the declarations were submitted in response to the Examiner's unsupported argument that the circular indicia shown in the figures were an

accidental by-product of several lines intersecting. The Appellant had orally communicated this to the Examiner during the first telephonic interview. The declarations had not been submitted earlier because, as discussed in the Appeal Brief in the Record of Interviews, Appellant's Attorney had been waiting to hear back from the Examiner's Supervisory Primary Examiner (SPE) as the SPE had told Appellant's Attorney that he would discuss the new matter issue with the Examiner and get back to Appellant's Attorney. The Examiner's SPE never contacted Appellant's Attorney prior to the last communication from the Examiner stating that the Examiner and her SPE were standing by the rejection. The overwhelming impression given to Appellant by the Examiner and her SPE on the new matter issue was that further prosecution would be futile as there was little doubt that their minds had been made up and an Appeal would be the most expedient way of resolving the new matter issue. The Examiner repeatedly stated that the circular indicia she saw in the figures were nothing more than a drafting error. The declaration of Aleen Ferris leaves no doubt that the circular indicia were not a drafting error and were intentionally shown in the figures. The need to file the Appeal was further buttressed by the Examiner's on-the-record waffling of whether or not Dionne disclosed subject matter relating to indicia positioned and/or extending from at least one of the axis at a 45 degree angle.

In view of the foregoing, it is clear that the Examiner has entered the declarations but has failed to provide any substantive rebuttal to the content of the declarations.

2. Response to Appellant's Arguments:

The Examiner's Supplemental Reply lacks any substantive response to the Appellant's arguments with respect to the use of the term 'marker'. The Board clearly

stated that the Examiner had not provided a full and complete response to the Appellant's arguments in regards to the disputed use of the term 'marker'. The Board stated that the record was not clear whether the Examiner considered the dictionary definition provided by the Appellant.

The Examiner merely stated that she cannot argue the written definition of any term and that her position is that the identification of a 'mark' or marker in the instant application has been arbitrarily and informally labeled based upon the Marquez reference (which the Examiner erroneously refers to as being 'newly discovered'). Instead of addressing the use of the term 'marker' as applied to the circular indicia shown in the figures, the Examiner engages in a tangential tirade with respect to Applicant's desire to provoke an interference with Marquez once the claims are deemed in condition for allowance. The Examiner mischaracterizes the Appellant's desire to provoke an interference with Marquez as some sort of attempt to convince the PTO to declare an interference based upon an application that was not in condition for allowance. The record clearly shows that the Applicant requested that an interference be declared between the instant application and Marquez as Applicant believed that Dionne clearly fails to disclose the claimed invention, leaving the claims in condition for allowance and the application in condition for an interference to be declared.

The Examiner argues that the term 'marker' was not clearly and concisely disclosed in the original specification to warrant entry into the instant application. However, the Examiner fails to provide any evidentiary or case law to support this position. The Examiner argues that because the circular indicia seen in the figures as originally filed were not described as 'markers' in the written description, as originally filed, then the

Appellant is not entitled to refer to these circular indicia in an amended written description as 'markers'. Clearly, the Examiner has once again demonstrated a complete lack of understanding of MPEP Section 2163.06 which unequivocally states that "information contained in any one of the specifications, claims or drawings of the application, as filed, may be added to any part of the application without adding new matter". According to the Examiner, she is right and MPEP 2163.06 is wrong.

The Examiner further failed to provide any definition of 'mark', or 'marker' or specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia shown in the figures is repugnant to the usual meaning of the term.

The Examiner additionally failed to provide any support for the Examiner's contention that the term 'marker' is an additional element separate from indicia forming the body placement guide. The Examiner implied that it was improper for Appellant to take the term 'marker' from Marquez U.S. 5,564,494 which described the same and/or similar circular indicia as a 'marker' yet the Examiner failed to provide any legal basis why it would be improper for Appellant to do so.

Without waiver of the above, it is clear that each of the intersections of the lines themselves, and not just the circular indicia at those intersections, can be described as a 'marker'. For example, as seen in FIG. 8 of Appellant's application (see Exhibit "G" of Appeal Brief), there are fifteen different locations where various lines identified by reference numbers 30, 32, et al. intersect to form a marker. Circular indicia, identified by reference numbers 56, 58 are located at the center of a number of those intersections of lines (i.e, 'markers').

Pursuant to MPEP 2111.01, an applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). In the Examiner's Answer, the Examiner states that the Examiner has consistently remarked that based upon the general definition of a mark, or marker, that there is no evidence in the disclosure to support the indicia Appellant claims as a 'marker'. The Examiner has never provided Appellant with any definition of 'marker' to support her contention. In fact, the Examiner has failed to even acknowledge the definitions of 'marker' and 'mark' provided by the Appellant in the Appeal Brief and has further failed in her Supplemental Examiner's Answer to specifically point out and distinctly explain how use of the term 'marker' to describe the circular indicia is repugnant either to the usual meaning of the term or the definitions provided by Appellant. The Examiner has obviously never heard of the age-old expression "X marks the spot". In this case, the circular indicia (as well as the fifteen individual intersections of lines shown in FIG. 8) clearly mark the spot(s) and can therefore be accurately described as 'markers'.

Usage of the term 'marker' to describe the circular indicia is repugnant neither to the term's well known usage nor the definitions provided by Appellant. The use of the term is completely consistent with the use of the same term in the Marquez patent as Marquez uses that very same term to describe circular indicia on the surface of the Marquez mat. The term 'marker' is therefore not being used in any manner as to give it a special meaning or a meaning repugnant to the usual meaning of the term. See MPEP 608.01(o) [Basis for Claim Terminology in Description].

Based upon the foregoing definitions, the manner in which the term 'marker' is used in the specification, and the source of the term (i.e., Marquez), it is clear that the term properly describes the circular indicia shown in the figures, especially in view of the intent to keep the language of claim 23 consistent with Marquez. The term 'marker' is completely consistent with the specification to describe the body placement guide as providing various marks/markers for a yoga practitioner to use to align their body during yoga exercises.

Based on the foregoing, it is clear that the term 'marker' is an appropriate word to use to describe the circular indicia shown in the figure, as originally filed.

3. Drawings:

The Examiner's Supplemental Reply, rather than clarifying the status of the amended drawings, has only further muddled the waters. The Board clearly stated that the present record is not clear as to whether the amended drawings submitted with the Response, filed August 19, 2002, has been properly entered into the record and approved by the Examiner. The Examiner failed to address these particular proposed amendments to the drawings and only mentioned drawings filed October 6, 2003 and February 11, 2004.

The Examiner disapproved of the proposed amendments to the figures filed by the Appellant on August 19, 2002 on the basis that the amended figures allegedly contained 'new matter' (i.e., reference numbers pointing to the circular indicia shown in the figures). As outlined above, the reference numbers are clearly not new matter as they reference numbers only point to circular indicia that were present in the figures at the time the figures were originally filed.

The amended figure of FIG. 8 submitted with the declaration of Ms. Ferris in October 6, 2003, was not entered by the Examiner. In her declaration, Ms. Ferris pointed out an error she found in the Appellant's proposed amendment to FIG. 8 filed on August 19, 2002. Ms. Ferris stated that the August 19, 2002 amendment to FIG. 8 was correct except for a single error. Ms. Ferris continued on to state that while the circular indicia in FIG. 8 are properly identified by reference numbers 56 and 58 at the intersections of the longitudinal axis 30 (i.e., the center vertical lines) with various lines, the reference numbers 58 that point to the intersections of the lines that are parallel to the left or right of the longitudinal axis 30 are incorrect and Ms. Ferris provided a corrected version of Figure 8 to be submitted for approval by the Board/Examiner that was attached to her declaration. However, the Examiner will not enter the proposed amendments as she considers the addition of the reference numbers pointing to the circular indicia to be 'new matter' despite the fact that the circular indicia were shown in the figures as they were originally filed.

With respect to the so-called 'formal drawings' filed February 11, 2004, it is clear that the Examiner did not even bother read the Appellant's Reply Brief in which the Appellant submitted a figure in Exhibit A. The Examiner states that FIG. 8 of Exhibit A of the Reply Brief includes additional handwritten lines [and labeling] that were not originally filed. This is true but had the Examiner actually read the Reply Brief, she would have found that page 22, first paragraph, of the Reply Brief clearly states that "[a] marked up version of FIG. 8 (with the lines forming the sides of the rectangles completed in phantom) has been provided for the purpose of providing clarity and is attached hereto in the Appendix as Exhibit 'A'". Nowhere did the Appellant state that the figure was being submitted as a formal drawing to be entered by the Examiner. On the contrary, the

Appellant clearly indicated that the marked up FIG. 8 in Exhibit A was only being submitted to provide clarity while reading the Appellant's following argument.

For the foregoing reasons, the rejections to the claims should be overturned.

Respectfully submitted,

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